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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/037,386	12/21/2001	Ronald Michalski	(13426)	6801

7590 12/13/2006

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EXAMINER
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CHAN, SING P

ART UNIT	PAPER NUMBER
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1734

DATE MAILED: 12/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/037,386

**Applicant(s)**

MICHALSKI ET AL.

**Examiner**

Sing P. Chan

**Art Unit**

1734

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 2-8, 17-21, 27, 28 and 30-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-8, 17-21, 27, 30, 32 and 33 is/are rejected.
- 7) ☒ Claim(s) 28 and 31 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_.
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 2-8, 17-21, 27, 30, and 32-33 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a height determination plate and an ultrasonic sensor to determines the distance between itself and the height determination plate, does not reasonably provide enablement for a broader limitation of a contact member and a sensor means. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims. The claims recite a broader limitation of a contact member and a sensor means but the specification only discloses a height determination plate as the contact member and an ultrasonic sensor as the sensor means and does not disclose any other example of contact members or sensors for the apparatus. Therefore, these claims are broader in scope than the specification.

### ***Allowable Subject Matter***

3. Claims 28 and 31 are would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 1st paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

4. The following is a statement of reasons for the indication of allowable subject matter: The claims recite an apparatus for applying stamps to cigarette cartons. The apparatus includes a height determination means comprising a horizontally oriented contact plate vertically movably in a reciprocating manner into contact with upper surface portions of different cigarette cartons having different height dimensions (Claims 27 and 30) and an ultrasonic sensor sensing the position of the plate (Claims 28 and 31). Winn discloses an apparatus for applying tax stamps to cigarettes in cartons. The apparatus includes a conveyor, a cigarette carton height determination station, a cigarette carton opening station with carton opening means, a tax stamp application station with tax stamp application means, cigarette carton closing station with carton closing means, and means for adjusting the height of the carton opening means and tax stamp application means. (Col 3, line 16 to Col 5, line 6) Wherein the photoelectric cells automatically determine the size or height of the carton. (Col 3, lines 39-42) Winn is silent as to the height determination means comprising a horizontally oriented contact plate vertically movably in a reciprocating manner into contact with upper surface portions of different cigarette cartons having different height dimensions (Claims 27 and 30) and an ultrasonic sensor sensing the position of the plate (Claims 28 and 31). Poulsen discloses an apparatus for box sealing and closing. The apparatus includes a height sensing means comprising of sensing arm (34) bent into an L-shaped formation and a finger member is swingably mounted on the free end for contacting the leading or front upper flap of the box (Col 4, lines 28-36), which is a functional equivalent of a horizontally oriented contact plate, wherein the arm moves up or down to press

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downwardly until the true height of the box is determined (Col 9, lines 17-23), and a sensing unit (37) providing a signal to a logic system (96) of the position of the arm to provide height data to the logic system. (Col 9, lines 17-35) Poulsen is silent as to the sensor is an ultrasonic sensor. A search of the prior art of record did not disclose reference or references in combination with the recited feature.

### ***Response to Arguments***

5. Applicant's arguments filed August 4, 2006 have been fully considered but they are not persuasive.

In response to applicant's argument of the claims being proper and enabling under 35 USC 112, the examiner disagrees, since the claims recite a broader limitation than the Specification and the Specification does not provide any additional example of sensors to provide additional means for measuring the distance. Furthermore, the Specification also recites the "structural feature and component which is integrally critical to the operation of the new and improved apparatus, machine, or system," which the examiner is interpreting as a critical and integrally important component to the apparatus and therefore is considered a required component. (See Specification, Page 11, lines 4-28)

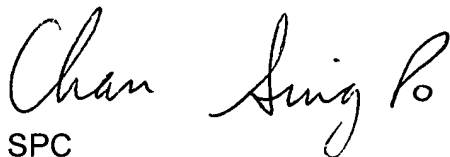
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sing P. Chan whose telephone number is 571-272-


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1225. The examiner can normally be reached on Monday-Thursday 7:30AM-11:00AM and 12:00PM-4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher A. Fiorilla can be reached on 571-272-1187. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
SPC

  
CHRIS FIORILLA  
SUPERVISORY PATENT EXAMINER  
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